REMARKS

Applicant has carefully reviewed the office action dated March 14, 2005. This response is believed to address all grounds for rejection stated in the office action and place the application in a condition for allowance. Claims 1-37 remain pending in this application. All pending claims are rejected.

Change of Correspondence Address

A petition to correct the office's error in changing correspondence address is enclosed. The Petition sets forth the facts pertinent as follows: In a prior office action, Applicant filed a revocation of then-existing powers of attorney and granted the powers to prosecute this case to the undersigned attorney. Along with that paper, a request to change correspondence address was enclosed. Attached to this filing is a copy of that filing. In light of the clear evidence that it was the Office's error, no fee is believed to be required. If however, a fee is required, Applicant respectfully requests notification and an opportunity to pay such fee. Please direct all future communications with respect to this Application to Customer Number **24490**. Telephone calls should be made to the undersigned at (650) 248-7011.

Change of Power of Attorney

As recited above, a revocation of existing power of attorney and grant of new power of attorney was filed with the November 16, 2004 response. As stated therein, please revoke the power of attorney to the present counsel and make the undersigned attorney of record with all powers to prosecute this application. Please direct all future correspondence with respect to this application to Customer Number **24490**.

Information Disclosure Statement

The Office Action stated that certain references cited in the IDS were not provided in hard copies. Applicant will file copies of all the references cited in a separate filing by mail. Examiner is respectfully requested to review and enter them in the record.

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Claim Amendments

Independent Claims 1 and 29 are amended to recite the disclosed features more clearly. Support for the amendments is in the Specification at Paragraphs 56 & 57 for "non-volatile" memory and Paragraph 9 for "graphics protocol engine". Because no new matter is added, Examiner is respectfully requested to review and enter the amendments.

Rejection of claims 1-37 under 35 U.S.C. § 102(e) as being anticipated by Lee (USP 6,336,137) (Web client-server system and method for incompatible page markup and presentation languages)

The Office Action rejected all the pending claims, claims 1-37, under 35 U.S.C. § 102(e) as being anticipated by Lee (USP 6,336,137). The Office Action discussed independent claim 1 and applied the discussion to all independent claims, thus rejecting all such claims for the same reason.

Law of Novelty under Section 102 of the Patent Act

To establish lack of novelty, one is required to prove that the reference met all the features of the claims in the application. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368 (Fed. Cir. 2003). Anticipation occurs if the prior art "explicitly or inherently discloses every limitation recited in the claims." *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997).

Discussion as Applied to the Independent and Dependent claims

As stated above, Claim 1 is amended to more clearly recite the features of the disclosure. As amended, claim 1 recites:

1. (presently amended) An apparatus comprising:

a client computer configured to fit in a person's hand, comprising:

a central processor unit;

a non-volatile memory device coupled to the central processor unit, said non-volatile memory being configured to store a graphics protocol engine, said graphics protocol engine comprising instructions to direct the central processing unit;

input device coupled to the central processor unit;

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a communication device coupled to the central processor unit and adapted to establish a wireless communication link with one or more remotely located server computers; and

a display device coupled to the central processor unit,

wherein said client computer device is adapted to act as a remote output device for one or more application programs running on said one or more remotely located server computers without the need for an execution environment on the client computer.

As stated above, this claim is amended to recite the features more clearly. Non-volatile memory is not new matter because it is described in the Specification at Paragraphs 56 & 57 as follows:

Paragraphs 56 & 57 provide:

[0056] As illustrated in FIG. 1 a client device 10 configured according to the principles disclosed herein includes a central processing unit 20 ("CPU"), which could be a general-purpose processor such as an Intel® StrongARM® processor or a special-purpose processor. The CPU 20 is connected through a bus 30 to, among other things, volatile memory 40 (also called RAM or random access memory), non volatile memory 50 (such as disk drives, CD-ROMs or data tapes), a network communications adapter 60 (such as an Ethernet card), an input means 70, such as a keyboard and/or a pointing or point-and-click device (such as a mouse, light pen, touch screen, touch pad, joy stick, jog dial), an output device, such as a video display screen and/or an audio speaker, and a removable media drive 80, such as a floppy disk drive, CD-ROM drive, PCMIA port, CD-WORM drive or data tape drive.

[0057] The client device 10 operates client software 90 for use with the present invention. The client software is shown graphically in

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FIG. 1 as being stored in <u>non-volatile memory</u> 50. However, it should be understood that it can also be stored in transportable media read by removable media drive 80. All, or portions of the client software 90 also can be loaded into volatile memory 40 (RAM), for example during operation. Exemplary transportable media implementing the client software (which may be in any form; such as source code, compiled or binary versions) include floppy disks, magnetic tape and optical disks, and others. In one embodiment, a client device is a portable computer such as a hand-held device and the electronic communications network is a wireless network connected to the Internet or an online service. Further, "Client device" or "Client device" 10 should be understood in this description to include any portable or hand-held device used for access an electronic communications network, such as a data processing system.

(Emphasis added). The features of <u>non-volatile</u> memory on the client and the lack of an <u>execution environment</u> on the client such as a Java Virtual Machine (see Background section in the Application at ¶ 005) are not present in Lee, and therefore Claim 1 is believed to be patentable. Note that Lee relies on the existence of a browser, which contains an execution environment such as a JVM, whereas the disclosure here does not require a browser program on a client. The Abstract discloses this succinctly, and distinguishes the term "thin client" as used in this application from that used in Lee. See Abstract, where the Applicant stated:

The thin client is not required to be equipped with an execution environment; rather, the client is used as a display device for applications that run on remote servers. Applications such as E-mail client, browser and others execute on a remotely located server, but use the client as a display and input device.

The same concept is also described in detail at ¶ 0854, where the Applicant states:

However, this invention will allow the browser application itself to run on a Company's Server. As apart of the application, the

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server sends "on action" requests on drawables that the client caches waiting for user actions. This new innovation brings additional capabilities.

The concept of an application such as a browser running on a server and exporting a display to the client is a feature of the instant disclosure. Lee, on the other hand used the term "thin client" to mean differently. *See, e.g.*, Lee at Summary, col. 4, lines 16-17, where Lee states:

The client may be a thin client or browser, as that term is generally understood.

This does not state much except that Lee uses the term "thin client" synonymously with that of a "browser." Lee later elaborates on "thin client" as follows:

In a preferred embodiment of our invention the client is a wireless client configured to send requests incorporating tokened requests for pages to the server and receive pages from the server, where tokened requests specify the language of the request and of the requested response, as WML, and where the server is configured to parse the tokened request from the client to determine the language of the request and the information requested; that is, WML, and recover information including views from a repository associated with the server; and to thereafter render a page to the client including information and views in the language of the request, as WML, and the view is a display with applets in the language requested by the client, as WML decks.

While the method and system of the invention have been described, illustrated, and summarized with respect to a class of wireless devices utilizing the Wireless Application Protocol (WAP) and the Wireless Markup Language (WML), it is, of course intended that the method and system of the invention may be employed in other browser or client configurations, formats, and form factors utilizing the WAP with WML, as well as in other clients and

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> browsers with bandwidths, processor speeds and capacities,
> memory capacity, and/or input/out capacity markedly different from
> those characteristics of PC based browsers and clients. A particular
> aspect of the method and system of the invention is that it is
> intended to work with browsers or clients that use other markup
> languages., and is not to be limited to WAP or WML

Lee, Col. 4, line 65 through Col. 5, line 25. This is not the same as the "thin client" described in the instant application. This is an important distinguishing feature which should not be ignored or misconstrued. See *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532, 3 U.S.P.Q.2D (BNA) 1321, 1324 (Fed. Cir. 1987) (stating that all meaningful claim limitations should be considered).

Claim 3 is patentable over Lee

The Office Action construed claims 3 & 4 and pointed to places in Lee for active application on the client (in the case of claim 3) and a cache (in the case of claim 4). This appears an error because in the Abstract that the Office Action pointed as for Claim 3, there is no mention of an "active" application on the client. The abstract of Lee states:

> Client-server systems and methods for transferring data via
> a network, including a wireless network, between a server and one
> or more clients or browsers that are spatially distributed (i.e.,
> situated at different locations). At least one local client computer
> provides a user interface to interact with at least one remote server
> computer which implements data processing in response to the
> local client computer. The user interface may be a browser or a thin
> client.

As seen, nothing in this is the same as the concept of "active" client application, which is at Paragraphs 115, 35, & 42 in the instant application. Paragraph 115 states:

> A session is said to be ACTIVE if an application is active and
> controls the display at a particular instant.

Paragraph 35 states:

> At a time only one application is considered ACTIVE in a VP
> client. The VP client could switch from application to application. As

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it does so, the drawables of suspended applications are deleted gradually to make space for new drawables for the active application. This form of lazy caching—i.e., not discarding cache soon after it is no more needed or actively accessed—is also commonly used in microprocessor memory hierarchies, virtual memory systems and caches in file systems.

See also, Fig. 5 and corresponding description at ¶ 42, and also recited in claim 3:

3. (original) The apparatus as in claim 1, wherein the one or more application programs include one active application.

Because Lee is entirely different and does not have the concept of an "active" application, Lee is distinguishable from the instant claim 3.

Claim 4 is patentable over Lee

As per claim 4, the Office Action pointed to Lee at Col. 12, line 17 for the word "cached" from which the Office Action reasoned that the "cache" used in claim 4 is disclosed in Lee. It is respectfully submitted that this is an error. Claim 4 states:

4. (original) The apparatus as in claim 3, further comprising: a portion of the memory device configured as a local cache; wherein drawables corresponding to the one or more application programs are stored in the cache for local retrieval and display.

First, it is noted that Claim 4 depends from claim 3, which is shown above to be distinguishable from Lee, and therefore Claim 4 is patentable as being dependent from a patentable claim. Further, claim 4 is independently patentable because the term "cache" in Claim 4 is qualified by the word "local" which is important. Note that the independent claim 1 (from which both claims 3 & 4 depend) is directed toward a client machine. Lee, at the cited part, states as follows:

When the web engine, 71, as the SWE, gets the request, it will get the repository objects, 77, referenced in the URL (SWEview, SWEapplet), shown in FIG. 5, from an associated repository, as the Siebel Object Manager ("SOM"), 73, and then instantiate the objects (if they are not already cached) and execute the specified command (SWEcommand and SWEmethodName),

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again shown in FIG. 5, on the objects. In a preferred embodiment, multiple templates can be applied to a view, where each view in the repository has a template in each page delivery language.

The part numbers in Lee, 71, 77 & 73 are important and they are depicted in Figs. 3 & 4 of Lee, where it is clear that these are server-side computers and not client entities. In Lee, the client is WAP Phone 41. Because the caching is done in the server and not in the client, Lee is distinguishable from Claim 4. Note at Paragraphs 56 & 57, the client is defined as a hand-held or portable device.

Independent claims 16, 29 & 30 are patentable over Lee

The remaining independent claims have additional features or elements that the Office Action did not address. Nor does Lee suggest or disclose these additional elements or features. For example, Claim 16 recites a "compound request", a second component to receive a "compound request" and a third component configured to ... update a display state of the client computer:

16. An apparatus comprising:

a client computer configured to fit in a person's hand, comprising:

a central processor unit;

memory device coupled to the central processor unit, said memory being configured to store instructions to direct the central processing unit;

input device coupled to the central processor unit;

a communication device coupled to the central processor unit and adapted to establish a wireless communication link with one or more remotely located server computers;

second component coupled to the memory device, said *second component configured to receive a compound request message from the server;*

third component coupled to the memory device, said *third component configured to use the compound request message to update a display state of the client computer; and*

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a display device coupled to the central processor unit,

wherein said client computer device is adapted to act as a remote output device for one or more application programs running on said one or more remotely located server computers over a wide-area mobile network without the need for an execution environment on the client computer.

(Emphasis added) Claim 29 recites that "the remote client is established as an input/output device for the server-run application." Lee does not disclose this feature.

29. (presently amended) An apparatus comprising:

a server computer, comprising:

a central processor unit;

a non-volatile memory device coupled to the central processor unit, said non-volatile memory being configured to store instructions for a graphics protocol engine to direct the central processing unit;

a communication device coupled to the central processor unit and adapted to establish a wireless communication link with one or more remotely located client computers; and

instructions stored in the memory device, said instructions configured to instruct the central processor unit to establish a session with a remote client over a wireless communication network, execute an application on the server computer, and establish a communication path with the remote client such that the remote client is established as an input/output device for the server-run application.

As modified, Lee does not have "non-volatile memory" or "graphics protocol engine." The term "graphics protocol engine" is disclosed at Paragraph 009 in the section entitled "Software Configuration on the Client Device". This feature distinguishes claim 29 from Lee.

Independent claim 30 recites that an application program executing on a server computer establishes a session with a client computer, exports its display to and receives

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a user's input [from a client computer] via a wireless network, and construes the user's input at the server computer. This feature also is not disclosed in Lee.

30. A method of establishing a client-server communication, said method comprising the steps of:

establishing a session between the client and the server computer, said client and server computer being connected using a wireless network;

executing an application program on the server computer;

<u>exporting display of the application program to the client</u>;

receiving a user input at the server computer; and

construing the user's input at the server.

(Emphasis added). Lee does not describe the feature of exporting a display to the client. Therefore, Applicant respectfully submits that all independent claims in the instant application are patentable over the cited art.

Further, because the independent claims are patentable, all dependent claims are also patentable. Reconsideration is respectfully requested.

<div align="center">Conclusion</div>

In view of the foregoing remarks, applicant believes that all rejected claims in the instant are in a condition for allowance. Reconsideration and an early notice of allowance are respectfully solicited. No fee is due with this response. If, however, a fee is deemed necessary, Applicant requests a phone call or other notice in order to comply.

Respectfully Submitted,

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<div align="center"><u>Certificate of faxing</u></div>
I certify that on the date shown below, I faxed this paper and the Petition to (571) 273-8300.

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